

REMARKS

Applicant has amended claims 1, 4, 6, 8, 9, 10, and 13 to more particularly and distinctly point out the claimed subject matter. Support for the amendments to the claims can be found in the as-filed specification, e.g., in paragraphs [0179] to [0204]. Applicant has cancelled claims 4, 7, and 14-16. Claims 1, 4, 6, 8-13, and 17 are currently pending.

Applicant has amended claims 1 and 10 in accordance with the Examiner's suggestions, and therefore respectfully requests that the objection to claims 1 and 10 be withdrawn.

Applicant respectfully requests reconsideration of the rejection of claims 1 and 4-17 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,667,285 to Kawahara et al. ("Kawahara") in view of U.S. Patent No. 6,228,282 to Shimomura et al. ("Shimomura").

Cancellation of claims 5, 7, and 14-16 renders moot the rejection of these claims.

Amended claims 1 and 10 each recite, among other things, "[a] refrigerating machine oil composition, consisting of: a base oil consisting of at least one type selected from mineral oils, hydrocarbon-based oils, aromatic esters, esters of C5-C10 linear aliphatic dibasic acids, polyol esters, complex esters, carbonic acid esters, polyoxyalkylene glycols, polyvinyl ethers, ketones, polyphenyl ethers, silicones, polysiloxanes, and perfluoroethers . . ." The transitional phrase "consisting of" used in amended claims 1 and 10 excludes any other elements not recited in the claims. See M.P.E.P. § 2111.03. As noted on page 4 of the Office Action, Kawahara's composition may contain other base oils such as alicyclic dicarboxylic acid esters esterified by monohydric alcohols, which are excluded from amended claims 1 and 10.

Moreover, Kawahara neither discloses nor suggests a refrigerating machine oil composition according to amended claims 1 and 10. Specifically, Kawahara neither discloses nor suggests the combination of the specific base oil, the specific phosphorothionate, the specific phosphorous-based extreme pressure agent other than said phosphorothionate, and the specific oil agent recited in amended claim 1. Kawahara also neither discloses nor suggests the combination of the specific base oil, the specific phosphorous-based extreme pressure agent, and the specific oil agent recited in amended claim 10. Kawahara rather teaches base oils not recited in the claims. For instance, Kawahara teaches a mixture of an ester (a) and a combination base oil (b) as an essential element to improve hydrostatic stability and viscosity. See e.g., Kawahara, col. 3, line 16 to col. 4, line 26. As acknowledged at page 4 of the Office Action, in the formula (1) of the ester (a) shown in claim 1 of Kawahara, R1 is a branched-chain alkyl when R2 is hydrogen. Hence, the esters of Kawahara are aliphatic saturated *branched-chain* carboxylic acid monoalkyl esters and thus are not one of the base oils and oil agents recited in amended claims 1 and 10.

Shimomura does not remedy the deficiency in Kawahara. Shimomura discloses or suggests a refrigerating machine oil composition consisting of the elements recited in amended claims 1 and 10,

For at least the foregoing reasons, Kawahara in view of Shimomura does not render obvious amended claims 1 and 10.

Claims 4, 6, 8-13, and 17 depend from claims 1 and 10 respectively, and incorporate all of the features of amended claims 1 and 10. Claims 4, 6, 8-13, and 17

also are allowable over the combination of Kawahara and Shimomura for at least the same reasons as those set forth above for amended claims 1 and 10.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: January 21, 2011

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